

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPHUS H. EGGEN

Appeal No. 1997-3909
Application 08/430,090

ON BRIEF

Before THOMAS, KRASS and HECKER, ***Administrative Patent Judges.***
HECKER, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 10 through 17, all of the claims pending in the application.

The invention relates to a device such as a computer, video recorder, cd-player, etc., wherein optional messages are contained for providing an elaboration on an aspect of the operating device. The optional messages (such as help messages) may be converted to speech form, and the speech may be reproduced at a normal speed or an increased speed.

Representative independent claim 10 is reproduced as follows:

10. In a device comprising:

(a) functionality means for executing a main function of the device,

(b) help means ancillary to the functionality means for assisting the user in operating the functionality means, said help means including:

(i) a plurality of non-speech-form help messages including messages relevant to the operation of the functionality means,

(ii) message selection means,

(iii) message reproducing means for converting any of said messages into speech form,

(c) user interface means connected to the functionality means and the help means and responsive to a user command for obtaining help in speech form in connection with operation of an aspect of said functionality means for selecting from said plurality of messages a help message

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relevant to said aspect;

the improvement comprising:

(d) means under user control for selectively causing the message reproducing means to render said selected help message at at least a first normal velocity or at a second faster velocity, said second velocity being faster than said first velocity to enable said user to quickly reach the part of said selected help message that may be of particular help in operating the functionality means.

The references relied on by the Examiner are as follows:

Yabuuchi	EP 0 402 911	Dec. 19, 1990
Appellant's Admitted Prior Art (APA)		

Claims 10 through 15 stand rejected under 35 U.S.C.
§ 103(a) as being unpatentable over the APA in view of
Yabuuchi¹.

Claims 16 and 17 stand rejected under 35 U.S.C.
§ 103(a) as being unpatentable over Yabuuchi².

¹ This is indicated as a new ground of rejection in the Examiner's Answer, paper no. 28. However, it is the same as that made in the Final Rejection, paper no. 21, with the omission of claims 16 and 17.

² This is indicated as a new ground of rejection in the Examiner's Answer, paper no. 28. It differs from that made in the Final Rejection, paper no. 21, in that the APA is no

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Rather than repeat the arguments of Appellant or the Examiner, we make reference to the brief (paper no. 27), reply brief (paper no. 29), supplemental reply brief (paper no. 36), answer (paper no. 28) and the supplemental answer (paper no. 35) for the details thereof.

OPINION

After a careful review of the evidence before us, we agree with the Examiner that claims 10 and 14 through 17 are properly rejected under 35 U.S.C. § 103. Thus, we will sustain the rejection of these claims but we will reverse the rejection of the remaining claims on appeal, claims 11 through 13, for the reasons set forth *infra*.

At the outset, we note that Appellant has indicated on page 7 of the brief that the claims stand or fall together in three groups. Group I includes claims 10, 14 and 15. Group II includes claims 11 through 13. Group III includes claims 16 and 17.

longer relied upon.

Considering the Group I claims, with claim 10 being representative thereof, the Examiner reasons that everything in this Jepson claim before "the improvement comprising:" is considered admitted prior art (APA). The APA teaches everything except selecting different velocities for voice message playback. Yabuuchi teaches altering the speed (velocity) of voice playback. The Examiner indicates that it would have been obvious to one of ordinary skill in the art at the time of invention to use Yabuuchi's selective playback modes (i.e., speeds) with the APA because of the universally recognized desirability of multi-speed playback in the audio/speech processing arts. (Supplemental answer-page 3.)

Appellant argues that the Examiner's reliance on Yabuuchi for altering voice playback speed is without merit. Appellant contends that Yabuuchi's teaching is merely a summary of the various playback modes, and that it is impermissible for the Examiner to select an isolated teaching from a reference without consideration of what the reference as a whole teaches to one of ordinary skill in the art. (Reply brief-pages 7 and 8.)

The cited portion of Yabuuchi states:

Referring to Fig. 12, **original voice playback** is a mode in which the recorded voice is played back at the **same speed** and pitch as those in the recording operation, **rapid talking playback** is a mode in which only the **speed** of the voice **is made higher** than in the recording operation without changing the pitch thereof, ...(emphasis added)(page 10, lines 10-13).

We see no problem with the Examiner relying on this passage for multi speed voice playback in Yabuuchi. Yabuuchi teaches multi-speed voice annotations. The cited passage does not waiver from what Yabuuchi teaches as a whole.

Appellant argues "Yabuuchi fails to teach anything regarding selected help messages, much less anything regarding playback of a selected help message at first and second velocities. ... Moreover, Appellant further submits that the playback of 'help information' is completely different from the playback taught by Yabuuchi." (Reply brief-pages 8 and 9.)

We fail to see the merit in this argument since the APA clearly sets forth the help message in speech form (see claim 10, section (b)). The Examiner merely relies on Yabuuchi for making the speech multi-speed.

Appellant cites *In re Donaldson*, 16 F.3d 1189, 1193,

29 USPQ2d 1845, 1848 (Fed. Cir. 1994), requiring proper credit for the "means-plus-function" claim language. Appellant complains that the Examiner has not identified an equivalent structure in at least one of the applied references which performs an identical function. Also, Appellant contends "In particular, the Examiner's Answer has never identified the structural changes necessary to convert the alleged prior art apparatus in accordance with the teachings [o]f the Yabuuchi reference so as to arrive at the invention of claim 10."

(Reply brief-page 11.)

We note that Appellant has not identified any corresponding structure in his own specification. We are also hard pressed to find any structure in the labeled boxes of Appellant's Figure 1 or the flow chart of Figure 2. Without further guidance, the claimed "means-plus-function" structure appears to be more function than structure. And, in that vain, Yabuuchi clearly recites the function of multi-speed voice annotation (indicated by the Examiner in Figure 12).

Appellant contends that the Examiner has used impermissible hindsight reconstruction and has proffered no references evidencing the "universally recognized" advantages.

(Reply brief-page 11.)

We assume the "universally recognized" advantages, missing evidence thereof, are multi-speed speech. We assume this because APA teaches the advantage of help information in speech form. Thus, it seems clear to us that the evidence of the desirability of multi-speed speech is in Yabuuchi itself, e.g., fast forward of a tape recorder (page 2, lines 13, 14).

We are unconvinced by Appellant's repeated arguments that Yabuuchi is devoid of help messages which in turn are ancillary to the main function of the device. Everything in claim 10 prior to "the improvement comprising:", a Jepson claim, is admitted prior art (APA). ***Ethicon Endo-Surgery Inc. v. U.S. Surgical Corp.***, 93 F.3d 1572, 1577, 40 USPQ2d 1019, 1022-23 (Fed. Cir. 1996). The APA clearly teaches the help messages (in speech form) which in turn are ancillary to the main function of the device. Appellant has not disputed the APA being the first part of a Jepson claim. The Examiner relies on Yabuuchi for making the speech multi-speed, for the advantages incumbent therein. Furthermore, Appellant's own specification recites an example of the invention as

"multimedia file reproduction" (page 1, line 8) much like Yabuuchi's "system which processes multi-media documents" (page 2, lines 3,4). Appellant's specification recites "The message reproduction means provide for example for the reproduction of annotations to a document being displayed,..." (page 1, lines 10-12), much like Yabuuchi's "voice processing of annotating voice messages to a document" (see abstract). Thus, for the reasons noted **supra**, we will sustain the Examiner's rejection of claim 10, and likewise claims 14 and 15 which stand or fall in the same group.

Looking at the Group II claims, with claim 11 being the representative claim, Appellant argues that the control for switching between first and second speech velocities operates **during** reproduction of a selected help message. Appellant contends the Examiner has completely ignored this limitation. Appellant notes that Yabuuchi selects playback speed from a menu (Figure 12) and closes this menu at the same time playback is initiated, thus Yabuuchi is devoid of speed switching **during** playback. (Reply brief-pages 12 and 13).

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We have thoroughly reviewed the answer and supplemental answer, and agree with Appellant. The Examiner has completely ignored the **during** limitation, which is not taught by Yabuuchi or APA. Thus, we will not sustain the Examiner's rejection of claim 11, and likewise claims 12 and 13 which depend therefrom.

Finally, we will consider the rejection of the Group III claims, claim 16 being considered the representative claim. We note that APA is not used in this rejection, and that Yabuuchi is the sole reference applied. Thus, Appellant's argument that help messages, **per se**, are not recited in Yabuuchi is more relevant here. However, as broadly recited in claim 16, we find that "help information" is met by Yabuuchi in its annotations. Annotations by their nature provide a further explanation or comment on the text to which they are attached. In providing an annotation, we find that such a further explanation or comment **helps** in understanding the text to which it is attached or is ancillary thereto.

Appellant repeats the means-plus-function argument

presented with respect to claim 10 (reply brief-page 16). As we stated **supra**, we find at least as much means and function in the applied references as identified by Applicant in his own specification. Thus, we will sustain the Examiner's rejection of claim 16, and likewise claim 17³ which stands or falls in the same group.

It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

In addition, the Federal Circuit reasons in **Para-Ordnance Mfg. v. SGS Importers** (Fed. Cir. 1995), 73 F.3d 1085, 1087-88, 37 USPQ2d 1237, 1239-40, that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem, and who

³ We note that in passing claim 17 lacks antecedent basis for "the means for fast forwarding".

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had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellant.

We find that those skilled in the art having the teachings of Yabuuchi before them would have seen the desirability of multi-speed in the voiced help messages of APA (re claim 10), and that the broadly recited help information of claim 16 is even anticipated by Yabuuchi. Lack of novelty is the ultimate of obviousness. See *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

In view of the foregoing, the decision of the Examiner rejecting claims 10 and 14 through 17 under 35 U.S.C. § 103 is affirmed; however, the decision of the Examiner rejecting claims 11 through 13 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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